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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,878	02/02/2004	Douglas Rowitch	030186U2	1054
23696	7590	10/19/2006		
QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121				
			EXAMINER BALAOING, ARIEL A	
			ART UNIT 2617	PAPER NUMBER

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/770,878

Applicant(s)

ROWITCH ET AL.

Examiner

Ariel Balaoing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Election/Restrictions

1. Newly submitted claims 8-12 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The inventions are distinct, each from the other because of the following reasons:

Claims 1-7 and 8-12 are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case claims 8-12 are drawn to specifics of a positioning engine locating within a mobile device and the processing of position information (class 455/456.6). Examined claims 1-7 are drawn to the process of authenticating a location based application of a mobile device (class 455/411). Claims 1-7 does not mention the use of the positioning techniques presented in claims 8-12.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8-12 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10769,420 in view of KRUIS et al (US 2004/0242209 A1).

Claims 1-7 of the instant application includes all of the limitations of claims 1-7 of copending Application No. 10769,420 except for:

(From claim 1) e. if the application is not authenticated, then failing to receive at least some information required to run the application in response to the application not being authenticated.

Although the conflicting claims are not identical, they are not patentably distinct from each other. KRUIS teaches wherein if the application is not authenticated, then failing to receive at least some information required to run the application in response to the application not being authenticated (paragraph 53). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the instant invention to include a method to limit information needed to run an application if authentication has failed, as taught by KRUIS, as this provides a safeguard against unnecessary use of system resources. Also it is inherent from copending claim 1 that if the application is not authenticated, then information required to run the application will not be received.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over POULIN et al (US 2002/0115453 A1) in view of KRUIS et al (US 2004/0242209 A1).

Regarding claim 1, POULIN discloses a method for authenticating an application, including: attempting to run a Location Based Service (LBS) application (abstract; paragraph 25); requesting authentication of the LBS application (paragraph 25, 28-30,

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36, 62-69; registration and activation required before service can be used. As noted in the applicant's specification, authorization involves verifying of subscribers identity and billing (see paragraph 1004 of the specification). Verification of a subscriber is needed to access proper user profile); communicating directly with a mobile positioning center (MPC) in order to have the MPC [100 – location based service center] fulfill the request for authentication of the LBS application (paragraph 25, 28-30, 36, 62-69; location based service center handles requests from all mobile devices); if the application is authenticated, then receiving within the mobile station information required to continue running the LBS application in response to the application being authenticated (paragraph 62-69, 71-74; once registered, user receives message that registration is complete and location based service requested becomes available). However, POULIN does not expressly disclose if the application is not authenticated, then failing to receive at least some information required to run the LBS application in response to the LBS application not being authenticated. KRUIS discloses if an application is not authenticated, then failing to receive at least some information required to run the LBS application in response to the LBS application not being authenticated (paragraph 53; KRUIS discloses both initial activation and real time management of services provided to a mobile station). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify POULIN to include a method to limit information needed to run an application if authentication has failed, as taught by KRUIS, since KRUIS states that such a modification would allow real time management

of services (paragraph 11, 12, 15, 16). Also it is inherent that if the application is not authenticated, then information required to run the application will not be received..

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of POULIN and KRUIS further discloses further including: if the application has not been authenticated, receiving a response message indicating that authentication failed (KRUIS – paragraph 53); and in response to receipt of the response message, halting the application (KRUIS – paragraph 53).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. POULIN further discloses wherein the LBS application that is attempted to run on the mobile station requires authentication from the MPC in order to receive all required information (paragraph 25, 28-30, 36, 62-69).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. POULIN further discloses wherein the authentication of the LBS application to be run on the mobile station is independent of other authentication operations to be requested by the mobile station for the purpose of authenticating telephone communication (abstract; paragraph 30-33, 62-69; the system of POULIN is used for provisioning of location based services).

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. POULIN further discloses wherein the authentication of the LBS application to be run on the mobile station is further independent of other authentication operations to be requested in order to authenticate

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other applications (abstract; paragraph 30-33, 62-69; the system of POULIN is used for provisioning of location based services).

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. POULIN further discloses wherein the authentication of the LBS application by the MPC allows the mobile station to communicate with other components (paragraph 40-41, 46, 56-58).

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. POULIN further discloses wherein the other components include a position determination entity [Location Finding Entity, 402].

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

PORTMAN et al (US 2002/0160766 A1) – Location Based Services

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ariel Balaoing – Art Unit 2617

AB


GEORGE ENG
SUPERVISORY PATENT EXAMINER